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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Evan John Kaye

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EXAMINER

WON, MICHAEL YOUNG

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,279

Applicant(s)

KAYE, EVAN JOHN

Examiner

Michael Y. Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed March 27, 2006.
2. Claims 1, 3-12, and 14-23 have been examined and are pending with this action.

Response to Amendment

The section of 37 CFR 1.131 for which the response pertains has been reproduced below:

37 CFR 1.131 *Affidavit or declaration of prior invention.*

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

3. The declaration filed on March 27, 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the U.S. Pat. No.6,611,814 (*Lee et al.*) reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the U.S. Pat. No. 6,611,814 (*Lee et al.*) reference. In the declaration, the applicant teaches of Exhibit A through Exhibit D. Only Exhibit A has been labeled and therefore references to the other exhibits can only be guessed using better judgment.

In response to Exhibit A, the applicant reproduces the current claims and simply states that he had completed his invention prior to July 17, 2000 without showing any other facts supporting his statement. In fact, the claims presented in Exhibit A are merely the state of the claims pending in the current application. This evidence does not sufficiently show a reduction to practice of the invention prior to the effective date of the *Lee* reference.

In response to Exhibit B and C, the applicant makes reference to Invoice No. 314073 and Invoice No. 321753, respectively. The examiner concurs that such exhibits are invoices to U.S. Patent Application 60/233,154 with client No. 3092, however merely stating that they are dated July 28, 2000 and September 13, 2000, respectively is insufficient to establish a reduction to practice. The dates on those invoices have been redacted if they even existed at all. Furthermore, the dates do not antedate July 17, 2000 of the *Lee* reference.

In response to Exhibit D, the applicant states that this exhibit is a correspondence between the applicant and his attorney concerning work done leading up to the filing of the provisional application, from a time prior to July 17, 2000 ending

with the filing of the application. If at best, the evidence shows a correspondence between the applicant and the attorney, but nothing more.

The evidence presented shows merely a reduction to practice from the filing of the provisional application to the filing of the patent application. There is insufficient evidence showing reduction to practice prior to the effective date of the reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 1, 10-12, 14-19, 22, and 23 have been rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (US 6,611,814 B1).

As per **claim 1**, Lee teaches a method for facilitating purchases of gift items that are made available for purchase from a host server, comprising the steps of:

a) downloading a component to a client machine (see Fig.3 and col.8, lines 61-65: "virtual wish list");

b) a user providing a permission for the downloaded component to access an address book maintained on the client machine (see col.8, lines 62-65: "users 101 can directly request");

c) retrieving at least a set of names of potential gift recipients from an address book (see col.6, lines 40-42 and col.7, lines 10-19) maintained on the client machine (see Fig.1, #701);

d) using the component, combining into a selection form at the client machine one or more gift items available through the host server and the set of names of the potential gift recipients (see Fig.11 and col.6, lines 42-46);

e) enabling the user at the client machine to associate from within the selection form the one or more gift items with particular names in the set of names to thereby define a set of intended gift recipients (see col.6, lines 19-21); and

f) forwarding to the host server a portion of the address book contents which concerns the particular names in the set of names that have been associated with the gift items (see col.6, lines 51-55 and col.12, lines 1-11).

As per **claim 10**, which depends on claim 1, Lee further teaches of including the additional step, once the set of intended gift recipients has been defined, of presenting at the client machine a shipping form which is automatically (see col.3, lines 43-48) populated with the names and shipping information for each of the intended gift recipients, the shipping information including an address which is retrieved from the address book (see Fig.7; col.6, lines 51-55; and col.11, line 65-col.12, line 11).

As per **claim 11**, which depends on claim 10, Lee further teaches of including the additional step of providing the names and shipping information of the intended gift recipients to the host server (see Fig.7; col.6, lines 51-55; and col.11, line 65-col.12, line 11).

As per **claim 12**, which depends on claim 10, Lee further teaches wherein the shipping information for at least one of the intended gift recipients is populated in the shipping form free of manual entry by the user (see col.3, lines 43-48; col.7, lines 18-19; and claim 10 and 11 rejections above).

As per **claim 14**, which depends on claim 1, Lee further teaches wherein the address book is retrieved from the client machine (see col.7, lines 18-19).

As per **claim 15**, which depends on claim 1, Lee further teaches wherein the address book is retrieved from a third party server (see col.3, lines 54-58).

As per **claim 16**, which depends on claim 1, Lee further teaches of including the additional step of executing the component at the client machine, which performs the retrieving and combining steps (see claim 1 rejection above).

As per **claim 17**, which depends on claim 1, Lee further teaches wherein the selection form displays, for each name in the set of potential gift recipients, any prior gift item associations that were made in a previous session with the host server so as to advise a user of a possible repeat gift item purchase (see col.4, lines 22-25).

As per **claim 18**, Lee teaches a method for facilitating purchases of gift items made available for purchase by a host server, comprising the steps of:

a) downloading to a client machine a component from the host server (see Fig.3 and col.8, lines 61-65: "virtual wish list"), the component including a selection template which coordinates with information in an address book which is accessible from the client machine (see col.6, lines 19-21 and col.7, lines 15-19);

b) retrieving into the component at least a set of names of potential gift recipients from the address book (see Fig.7 and col.11, lines 57-65);

c) retrieving from the host server a set of gift items, each of which is associable with one or more names in the set of potential gift recipients (see Fig.11; Fig.12; and col.9, lines 17-20);

d) displaying in a browser operating at the client machine a matrix of selection cells which is defined by intersecting rows and columns, one of the rows and columns denoting the set of gift items and the other denoting the names in the set of potential gift recipients (see Fig.12); and

e) enabling the user to associate names in the set of potential gift recipients with gifts in the set of gift items by interacting with one or more selection cells to thereby define a set of intended gift recipients (see col.6, lines 19-21).

As per **claim 19**, which depends on claim 18, Lee further teaches of including the additional step of providing the set of intended gift recipients to the host server free of manual entry of the names of the intended gift recipients (see col.3, lines 43-48; col.7, lines 18-19; and claim 10 and 11 rejections above).

As per **claim 22**, which depends on claim 1, Lee further teaches including the additional step of adding the gift items available for purchase from the host server to an electronic shopping basket, wherein steps (b) through (f) are performed after the adding step in connection with a checkout by the user at the client machine (see col.col.5, line 65-col.6, line 39).

As per **claim 23**, Lee teaches a method for facilitating purchases of gift items that are made available for purchase from a host server, comprising the steps of:

using a browser executing at a client machine (see col.5, lines 54-59), adding the gift items available for purchase from the host server to an electronic shopping basket (see col.6, lines 1-6); and

in connection with a checkout by a user at the client machine (see col.6, lines 7-10):

a) prompting the user with a permission request to access a particular address book including at least a set of names (see abstract: "Recipients are asked for permission");

b) testing for the presence of a component on the client machine (see col.6, lines 43-46); and

c) in the event that the component is present on the client machine:

1) retrieving at least the set of names from the particular address book using the component (see col.6, lines 40-42 and col.7, lines 10-19);

2) constructing a selection form which presents a matrix of selection cells, wherein each selection cell is at the intersection of a particular one of the added gift items from the electronic shopping basket and a particular name from the retrieved set of names (see Fig.11; Fig.12; and col.9, lines 17-20);

3) displaying in the browser the constructed selection form (see Fig.12);

4) enabling the user at the client machine to associate from within the selection form at least the particular one of the gift items with at least the particular name to thereby define a set of intended gift recipients (see col.6, lines 19-21); and

5) forwarding to the host server the set of intended gift recipients including at least the particular name retrieved from the particular address book (see col.6, lines 51-55 and col.12, lines 1-11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-9, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US 6,611,814 B1) in view of Chui et al. (US 6,657,702 B1).

As per **claim 3**, which depends on claim 1, Lee does not explicitly teach of including the additional step of enabling the user at the client machine to associate a message with a potential gift recipient. Chui teach of including the additional step of enabling the user at the client machine to associate a message with a potential gift recipient (see col.3, lines 13-15; col.11, lines 30-34; and col.14, lines 52-65).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Chui within the system of Lee by implementing including the additional step of enabling the user at the client machine to associate a message with a potential gift recipient within the method for facilitating purchases gift items because Lee teaches that the system is applicable to purchasing products via the Internet for others, namely as gifts (see col.1, lines 25-31 and col.6, lines 14-18) which consist of personal messages or notes, reasons for the gift given, who the gift is from, etc.

As per **claim 4**, which depends on claim 3, Chui further teaches wherein the message is entered by the user (see Fig.5, #522; column 11, lines 30-34: "personal message"; and column 15, lines 40-45).

As per **claim 5**, which depends on claim 3, Chui further teaches wherein plural messages can be entered by the user, and wherein the user can select any one of the plural messages for associating with a particular recipient in the set of potential gift recipients (see Fig.5, #522; column 11, lines 30-34: "personal message"; and column 15, lines 40-45).

As per **claim 6**, which depends on claim 3, Chui further teaches wherein plural messages are displayed at the client machine, any one of which is associable with a particular recipient in the set of potential gift recipients (see Fig.5, #522; column 11, lines 30-34; and column 15, lines 40-45).

As per **claim 7**, which depends on claim 3, Chui further teaches wherein the selection form further includes the at least one message which the user is enabled to associate with the potential gift recipient (see Fig.5, #522; column 11, lines 30-34; and column 15, lines 40-45).

As per **claims 8 and 20**, which depend on claims 1 and 18, respectively, Lee does not explicitly teach wherein the association of gift items with potential gift recipients, is made by selecting a radio button, which is displayed at the client machine. Chui teaches wherein the association of gift items with potential gift recipients, is made by selecting a radio button, which is displayed at the client machine (see col. 16, lines 40-48).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Chui within the system of Lee by implementing associating of gift items with potential gift recipients, is made by selecting

a radio button, which is displayed at the client machine within the method for facilitating purchases gift items because the means of selecting via the web is subjective and because such subjective means will the functionally distinguish the invention in terms of patentability.

As per **claims 9 and 21**, which depend on claims 1 and 18, respectively, Lee does not explicitly teach wherein the association of gift items with potential gift recipients, is made by selecting a checkbox, which is displayed at the client machine. Chui teaches wherein the association of gift items with potential gift recipients, is made by selecting a checkbox, which is displayed at the client machine (see col.18, lines 20-24).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Chui within the system of Lee by implementing associating of gift items with potential gift recipients, is made by selecting a checkbox, which is displayed at the client machine within the method for facilitating purchases gift items because the means of selecting via the web is subjective and because such subjective means will the functionally distinguish the invention in terms of patentability.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

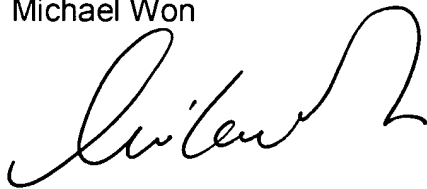
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Won



May 31, 2006



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER